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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/835,733 04/16/01 SCHLIEFFERS

J TELNP226US

MM92/0620

EXAMINER

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ART UNIT	PAPER NUMBER
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2876

**DATE MAILED:** 06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Offic Action Summary</b>	<b>Applicati n N .</b>	<b>Applicant(s)</b>
	09/835,733	SCHLIEFFERS ET AL.
	<b>Examiner</b> Diane I. Lee	<b>Art Unit</b> 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 16 April 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1 and 14-34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 14-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
16) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	20) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 16 April 2001. Claims 2-13 have been canceled and claims 14-34 have been newly added. Currently, claims 1 and 14-34 are pending in this application.
2. Acknowledgment is made that this application is a continuation of Application Serial No. 09/528,239 filed 17 March 2000, which issued as U.S. Pat. No. 6,123,265, which was a continuation of application Serial No. 08/883,357 filed 26 June 1997, which issued as U.S. Pat. No. 5,979,770.

### *Double Patenting*

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 09/528,239. Claim 1 of the instant application is identical to the claim 1 of copending Application No. 09/528,239. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 14-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,123,265-referred as patent'265. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 14-21 of the instant application, applicant claims a hand-held optical scanning device comprising a body including an upper surface having an optical scanning module, a display mounted, and keypad; a handle having a trigger that extends from a bottom surface of the body, the handle being jointed at a selected angle with respect to the body to cause a proximal end of a bottom surface of the body to rest on a radial surface of a user's hand when the user grasps the handle, the handle being configurable to accommodate the user's hand, and etc. or mitigate exertion of unsupported force on a grip of the handle by force of keystrokes. The patent'265 discloses a hand-held optical scanning device comprising a body portion having a bar code reading module (i.e., an optical scanning module arranged to scan objects in a direction), a display, and an input means; a handle portion having a trigger for activating the module, the handle extends at an angle from forward port of the body portion, the bottom surface of the top portion (i.e., the body portion) is configured to rest on top of a user's hand when the handle is gripped with the hand of a user. Although, the scope of claims 14-21 of the present application and claims 1-9 of patent'265 are almost identical in structural, the difference between the present claimed invention and the patent'265 is the purpose which obviously provided by the structural limitation of the optical scanning device (i.e., the proximal end of the bottom surface of the body to rest on a radial surface of a user's hand to mitigate exertion of unsupported force on a grip of the handle by force of keystrokes.

Thus, in respect to above discussion, it would have been obvious to an artisan of ordinary skill in art at time the invention was made to recognize that such structural limitation (i.e., body portion having a keypad which rests on a wrist of a user and ergonomically distributes the weight of the scanning device over the wrist of the user) would obviously mitigate exertion of unsupported force on a grip of the handle by force of keystrokes. Therefore, the instant application obviously encompass the claimed invention of the patent'265.

*Claim Objections*

7. Claims 21-24 are objected to because of the following informalities:

- (a) Re claim 21, line 6: “a grip the handle” should be changed to –a grip of the handle--;
- (b) Re claim 23, line 1: “the trigger being” should be changed to –the handle including a trigger having--; and
- (c) Re claim 24, line 1: “the trigger” should be changed to –the handle including a trigger--.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 21-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- (a) Re claim 21: applicant recites a hand held optical scanning device comprising a body having an scanning module and a display mounted thereof, and a handle....., the handle being joined to the body to cause ...bottom surface to rest on a radial surface of the user's hand so as to mitigate exertion of unsupported force on a grip of the handle by force of keystrokes. Nowhere in the claims recites a means

such as a keyboard or keypad to provide an exertion force on a grip. Thus, it is unclear to the examiner how the hand held device mitigate the exertion force of keystrokes without the structural limitation (i.e., keyboard). Accordingly, the applicant fails to provide a means in the hand held optical scanning device to carry out the function (i.e., providing an exertion force of keystrokes on a grip of the handle).

Therefore, claim 21 and claims which depend therefrom, claims 22-34, are vague and indefinite.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 14, 16-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Petteruti et al. [US 5,335,170-referred as Petteruti].

Re claim 14: Petteruti discloses a hand-held optical device 50, comprising:  
a head portion 44 and the master module 10 as a body which include an upper surface having a display 34 mounted thereof (see figure 2A);

a handle 112 that extends from a bottom surface of the body, the handle being joined at a selected angle with respect to the body to cause a proximal end of a bottom surface of the body to rest on a radial surface of a user's hand when the user grasps the handle, (the specific illustration not shown in figure),  
the handle being configurable to accommodate the user's hand (see figure 2A).

Re claims 16-17: Petteruti teaches the scanning device having a RF antenna 40 and associated RF electronics 39 to allow wireless RF communication (see col. 2, lines 28+).

Re claim 20: Petteruti discloses the body portion having a CCD scanner 90, a controller 98, a LCD display 34, a keyboard 36, and EEPROM 112. The EEPROM which is controlled by the input means

to control the output of the charge pump which in turn controls the contrast of the display 34 (see col. 6, lines 30+). Therefore, the display is configurable to adapt to a user's preference.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 21-24, 28-29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti. The teachings of Petteruti have been discussed above.

Re claims 21, 29, and 32: Although Petteruti shows the optical scanning device having a body and a handle joined at a selected angle to cause a proximal end of a bottom surface of the body to rest on a radial surface of a user's hand, he is silent with respect to the benefits which provided by such structural, i.e., mitigating exertion of unsupported force on a grip of the handle by force of keystrokes.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the bottom surface (i.e., the proximal end of the body portion that connecting the handle) applies its weight to the user's hand when the user grasps the handle portion and

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distributes its weight of the scanning device over the wrist of the user. Therefore, any exertion force on a grip of the handle (e.g., its weight, keystrokes, or etc.) would be mitigated according to the surface area.

Re claims 22-24 and 28: Petteruti shows that the handle is integrally molded with the bottom of the body and includes a trigger 46 which activates the scanner (i.e., actuate the reading process). The trigger can be single or dual finger trigger (i.e., the user may apply a single or dual fingers to actuate the trigger) (see figure 2A).

15. Claims 18-19, 25-27, and 30-31 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of Reynolds et al. [US 5,828,052-referred as Reynolds]. The teachings of Petteruti have been discussed above.

Re claims 18, 25-27, and 30: Petteruti does not disclose the body including a lower housing member and an upper housing member that forms a cover, a resilient sealing member interposed between the lower housing member and cover to form a dust and moisture resistance seal therebetween.

Reynold discloses a hand-held optical scanning device 20 having a body portion 22, 34 and a handle portion 26 that extends from a bottom surface of the body portion. The handle being joined at a selected angle with respect to the body to cause a proximal end of a bottom surface of the body to rest on a radial surface of a user's hand when the user grasps the handle. Reynolds further teaches that the body portion include a lower housing member 34 and an upper housing member 22 that forms a cover (see figure 3). The lower housing is made of elastomers to protect underlying surfaces of the scanner and extends a distance to cover substantial portion of periphery of the body. The lower housing provides an environmental protection by acting as a gasket between the body and the handle portions thereby inhibiting contaminants from entering into the interior of the scanner (see col. 3, lines 56+). This lower housing that is made of elastomers provides the claimed function of a resilient sealing member interposed between the lower housing member and cover to form a dust and moisture resistance seal therebetween. The lower housing also provides a bumping surface that protects a user's hand (see col. 3, lines 53+).

In view of Reynol's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the design structure of the body portion in the scanning device of Petteruti in order to provide an ergonomic structural of scanning device and to protect the internal components of the scanner from environmental contaminants.

Re claims 19 and 31: Petteruti is silent with respect to the displaying being a digital display. However, due to the fact that Petteruti teaches that the scanning device having a controller 82 which processes the digital signal (see col. 5, lines 57+ and col. 6, lines 4+). Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the display device would be a digital display since the controller controls the CCD scanner and the display device thereof.

16. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of Tracy et al. [US 5,979,757-referred as Tracy]. The teachings of Petteruti have been discussed above.

Petteruti does not disclose the display being configurable vertically to provide portrait view and horizontally to provide landscape view.

Tracy discloses a hand-held optical scanning device for communicating information over a wireless communication network. Tracy shows that the a hand-held optical scanning device having a display and a reconfiguration key setting 79A which permits the system to automatically reconfigured its display (see figure 2). This reconfiguration key will automatically reconfigure the display to change the display configuration from the first configuration (i.e., the horizontal configuration to provide a landscape view) to a second configuration (i.e., the vertical configuration to provide a portrait view) (see col. 5, lines 10+).

In view of Tracy's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a display having a reconfiguration function in the device

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of Petteruti in order to provide a display which capable to reconfigure its orientation to reflect the user's preference.

*Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schlieffers et al. [US 5,979,770], Swartz [US 4,496,831], Krichever et al.[US 4,896,026], Eastman et al.[US 5,200,597], Wakatsuki [JP 02-144,681], and Sumitomo [JP 02-183,386] discloses a hand held scanning device having a body and a handle portion along with a display and a keypad thereon; Jambhekar et al. [US 5,742,894] discloses a hand-held device having a display that is reconfigurable to a portrait and a landscape views.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Diane I. Lee  
Examiner  
Art Unit 2876

*D.L.*  
D.L.  
June 11, 2001

*Karl D. Frech*  
KARL D. FRECH  
PRIMARY EXAMINER